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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1968

No. 1346

GIULIO NATTA ET AL, *Petitioners,*

against

ALEX ZLETZ AND
STANDARD OIL COMPANY OF INDIANA,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Giulio Natta, Piero Pino and Giorgio Mazzanti, petitioners, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered on March 10, 1969, in Appeal No. 17,391 in the above-entitled case. The district court did not file an opinion, but announced its ruling in open court, which ruling was later formalized by a written order, *infra,* p. 2a. The Court of Appeals did not file an opinion, but rather disposed of Appeal No. 17,391 by summary order, *infra,* p. 5a. The two prior opinions of the Court of Appeals in this case are reported at 379 F. 2d 615 and 405 F. 2d 99.

JURISDICTION

The judgment of the court below was entered on March 10, 1969. A timely petition for rehearing was denied on April 7, 1969. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTION PRESENTED

Particularly in a documentary discovery proceeding under 35 U.S.C. 24 where the federal courts exercise "an authorized ancillary jurisdiction—a jurisdiction designed to cooperatively complement Patent Office jurisdiction as an aid to the quest for truth" in patent interference proceedings, *Natta* v. *Zletz*, 379 F. 2d 615, 618 (7 Cir. 1967) quoted in *Natta* v. *Hogan*, 392 F. 2d 686, 691 (10 Cir. 1968) and having due regard to the paramount public interest in the expeditious issuance of valid patents, and in the termination of litigation, the questions arising on this petition, the interference proceeding to which the case is ancillary having been declared by the Patent Office more than ten years ago, are:

(1) Was the lower court free to depart from the rule "that an inferior court has no power or authority to deviate from the mandate issued by an appellate court", *Briggs* v. *Pennsylvania R. Co.*, 334 U.S. 304, 306 (1948), to "affirm" the district court's "Final Order After Remand" which expressly provided that petitioner should "*not*" receive a portion of the documentary discovery which the mandate ordered?

(2) Was the lower court free to refuse to apply against respondents the established rule of the federal appellate courts that points raised in the district court but not briefed or argued on appeal are abandoned and on that basis to direct a resumption of proceedings in the district court thus unnecessarily prolonging this ancillary litigation?

STATUTES AND REGULATIONS INVOLVED

This case involves 35 U.S.C. (*infra*, p. 1a); 35 U.S.C. 135 (a) (*infra*, p. 1a); and 28 U.S.C. 1254(1) (*infra*, p. 1a).

STATEMENT OF THE CASE

This petition seeks review of the judgment in the third appeal (No. 17,391) in this case. The third appeal was

precipitated by the action of the district court in writing an express exception favorable to respondents into the mandate from the second Appeal No. 16,997 which was decided adversely to respondents. The court below, in the judgment to which this petition is directed, purported to conditionally "affirm" this usurpation of prerogative by the trial judge.

In its opinion filed December 19, 1968 (A593)[1] in the second appeal (No. 16,997), the court below summarized the nature of the litigation and the prior proceedings as follows: "In September 1958, the United States Patent Office instituted Interference No. 89,634 to determine which of four applicants for a patent first invented a plastic product known as solid polypropylene. Defendants Zletz and his assignee, Standard Oil Company of Indiana ('Standard') [respondents here], and other junior parties to the Interference introduced evidence before the Board of Patent Interferences in an attempt to advance their invention dates prior to the date to which plaintiffs ('Natta') [petitioner here], as the senior parties to the Interference, are presumptively entitled. See 37 C.F.R. § 1.257(a). In June 1966, Natta filed an ancillary action under 35 U.S.C. § 24 seeking the production of documents of defendants, pursuant to Rule 34 of the Federal Rules of Civil Procedure, for use in Natta's rebuttal case before the Board. In November 1966, the production motion was denied on jurisdictional grounds, resulting in reversal by this Court. (See 379 F. 2d 615.)

"During the subsequent proceedings in the district court, defendants made numerous documents available to Natta. However, in May 1968, the district court entered an order refusing access to three categories of defendants' documents" (405 F. 2d 99, 100; A593).

The Court then announced the general nature of its ruling in the second Appeal No. 16,997 as follows:

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[1] On January 30, 1969 the court below ordered that ". . . the 2-volume appendix in Appeal No. 16,997 will be deemed Volumes I and II of the appendix . . . [in Appeal No. 17,391]". Documents reflecting the relevant

"... We now set aside this order as unduly restrictive and not in accord with the broad type of discovery and duty of full disclosure contemplated by the patent laws, including 35 U.S.C. § 24. *In re Natta*, 388 F. 2d 215, 217 (3d Cir. 1968); *Natta* v. *Hogan*, 392 F. 2d 686, 691 (10th Cir. 1968). The maximum amount of evidence should be available to the Patent Office for its sifting of the interference issues. . . ." (405 F. 2d 99, 100; A594)

Apposite on this petition is the specific ruling in Appeal No. 16,997 which unqualifiedly rejected respondents' objection to producing post-October 15, 1954 documents. In overruling the trial judge on this issue, the appellate court held:

"Finally, the district court selected October 15, 1954, the date of Zletz's application, as the cut-off date for discovery. Since it is well settled that events following the date of a patent application may cast doubt on the patentability of the product . . . the cut-off date selected was improper. Subsequent documents may bear on events prior thereto and also on any actual reduction to practice by Standard. *They should be produced if they are in the categories already sought by Natta.*" (405 F. 2d 99, 102; A596-597)

Respondent having presented no request for rehearing, the court below filed its mandate in Appeal No. 16,997 on January 14, 1969. The mandate "ordered . . . that this cause be . . . REMANDED to the said District Court, in accordance with the opinion of this Court. . ." (A598).

THE MANDATE ISSUE

On January 17, 1969, two days after the mandate from Appeal No. 16,997 was received by the district court, peti-

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proceedings after the remand from Appeal No. 16,997 were presented as Volume III of the Appendix in Appeal No. 17,391. Volume III continued the pagination of Volumes I and II and thus begins with Appendix page 591.

In this petition citations to the record below are largely to this 3-volume Appendix, thus (A—). Unless otherwise stated, all emphasis has been added.

tioner filed and moved in open court for entry of a proposed "Final Order after Remand" (A600). This proposed "Final Order" was carefully drafted to conform to the appellate opinion which the mandate incorporated. It included paragraphs B and C(3) as follows:

> "B. To the extent it has not already done so, *Standard shall produce* for inspection by Natta counsel all of the documents with respect to which Standard's objections were sustained by said hereby vacated Final Order, *subject* ONLY *to the terms and conditions set forth in the aforementioned opinion of the United States Court of Appeals for the Seventh Circuit . . .*;
>
> "C. Specifically, but only by way of elucidation and not in limitation of the foregoing paragraphs A and B hereof, Standard shall produce for inspection by counsel for Natta et al:
>
> . . . . . .
>
> "(3) *all documents dated subsequent to October 15, 1954 in the categories already sought by Natta.*" (A613-614)

It will be noted that the words "in the categories already sought by Natta" are taken verbatim from the opinion in Appeal No. 16,997 (A597).

Respondents objected to petitioner's proposed order on the ground that "many" of the post-October 15, 1954 documents, although "in the categories already sought by Natta" "would be privileged and work product" (January 17, 1969 Transcript; A607).[2]

The district court sustained respondents' objection. On January 21 the district court signed "nunc pro tunc" as of January 17, 1969 *respondents'* version of a "Final Order after Remand", which expressly provided, contrary to the mandate in Appeal No. 16,997, that respondents "shall *not* be required" to produce those documents dated subsequent

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[2] An alleged "List" of these documents (reproduced *infra*, p. 6a) has now been filed with the district court. It is apparent from inspection of this "List" that hundreds or even thousands of pages of material are included.

to October 15, 1954 and "in the categories already sought by Natta" *which respondents might themselves judge to be subject to privilege or work product immunity.* Specifically the district court's January 21, 1969 order defined an express exception to the mandate by stating that respondents should produce the documents requested by the production motion

> "B. . . . *subject only* to the terms and conditions set forth in the aforementioned opinion of the United States Court of Appeals for the Seventh Circuit AND *paragraph D hereof;*
>
> "C. Specifically, but only by way of elucidation and not in limitation . . . Standard shall produce for inspection by counsel for Natta et al:
>
> * * * * *
>
> "3. all documents dated subsequent to October 15, 1954 in the categories already sought by Natta.
>
> "D. Notwithstanding anything in the prior provisions of this Order, Standard shall not be required to produce documents constituting or disclosing confidential communications between Standard the client and counsel for Standard and relating to the seeking of, or giving of, legal advice of any kind, nor shall counsel for Standard be required to submit to Natta or its counsel any documents in the nature of attorney's work product developed in anticipation of Interference 89,634 or in anticipation of these proceedings." (A626-628)

On January 20, 1969, petitioner, believing that the district judge lacked prerogative to rule that respondents "shall *not* be required to produce" a portion of the documents falling within the literal language of the mandate from Appeal No. 16,997, sought relief by petition for an extraordinary writ. The writ was summarily denied January 22, 1969 [3] and Appeal No. 17,391 duly noticed on January 24, 1969 (A629).

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[3] The order denying the writ appears *infra*, p. 23a.

On January 30, 1969, in granting petitioner's motion to expedite proceedings and to suspend the rules, the court below fixed an abbreviated briefing schedule, ruled that the case would be taken under advisement without oral argument, and requested the parties in their briefs to discuss, *inter alia:*

> ". . . whether *appellees* have *waived* the attorney-client and work product privileges specified in paragraph D of the district court's order of January 21, 1969, *by failure to raise the issue in Appeal No. 16997*, or for other reasons. . . ."[4]

On March 10, 1969 the court below disposed of Appeal No. 17,391—without opinion—by a summary order in pertinent part stating:

> "The principal question presented by this appeal is whether our mandate of January 14, 1969, following the issuance of our opinion reported in 405 F. 2d 99, precluded the district court from entering an order excepting from appellant Natta's documentary inspection appellee Standard's attorneys' work product and confidential communications between them and Standard with respect to certain legal advice.
>
> "Upon consideration of the briefs and the appendix, the district court's order of January 21, 1969, is affirmed, but without prejudice to Natta's contesting Standard's work product and privilege claims on the merits before the district court."[5]

On April 7, 1969 a timely petition for rehearing *en banc* was denied.[6] On April 9, 1969 petitioner filed a request to expedite the mandate which resulted in issuance of such mandate on April 11, 1969.[7]

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[4] The January 30, 1969 order appears *infra*, p. 2a.

[5] The March 10, 1969 order appears *infra*, p. 5a.

[6] The April 7, 1969 order denying rehearing appears *infra*, p. 25a.

[7] The purpose of the request was to expedite such proceedings as may be appropriate in the district court and thus to avoid any unnecessary delays in the Patent Office disposition of Interference 89,634. We are of the considered opinion, however, for the reasons stated in this petition that the

The court below has condoned the usurpation of prerogative by the district court to limit the scope of its January 14, 1969 mandate in Appeal No. 16,997. It has done so by its own *ex post facto* "interpretation" of that mandate to include an express exception not recited in it and inconsistent with its plain language.

Further, by its March 10, 1969 order the court below expressly recognized that the district court's order was *erroneous because respondents were permitted to judge for themselves* the merits of their work product and privilege claims. The court below did *not* vacate the district court's order in view of this acknowledged error as it should have. Rather, again resorting to "interpretation", it construed that order—just as it had previously construed its own mandate, to include an unrecited and irreconcilable provision—to wit, a right in petitioner to contest "Standard's work product and privilege claims on the merits before the district court". And, on the pretext that the district court's order contained such a provision, "affirmed" the order.

If the district court's January 21, 1969 order *in fact* included such a right in petitioner then the court below had *no* jurisdiction in Appeal No. 17,391 because the January 21, 1969 order was not "Final" and hence not appealable under 28 U.S.C. 1291. In such a case, Appeal No. 17,391 should have been dismissed as premature. But, of course, the January 21, 1969 order was, in fact, "Final," having been so designated by the district judge, and, as such, was admittedly erroneous. It was not the province of the appellate court to salvage the order by "interpretation" and on that ground to affirm. Indeed, the purported affirmance is inconsistent with the condition (Natta's right to contest in the district court) to which it is subject.

Not surprisingly, the court below elected to dispose of Appeal No. 17,391 by summary order, rather than by an attempt to explain in a reasoned opinion its manifest de-

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judgment in Appeal No. 17,391 must be vacated and that there should be no further proceedings in the district court, whereby maximum expedition in the disposition of the interference proceeding will be achieved.

parture from the accepted and usual conduct of judicial proceedings.

THE WAIVER ISSUE

Petitioner's production motion requests 26 categories of documents. It recognizes no exception for documents which might be alleged by respondents to be immune from production on work product or privilege grounds. Instead it expressly includes all such material (A2).

Respondents admitted in the district court at the January 17, 1969 hearing that "This privilege problem and work product has been in this case from the beginning. In our very first brief that was filed in the summer of 1966 we recognized this" (A607), and that "When we filed our formal objections [A539] last year objecting to producing documents after October 15th, 1954, we told your Honor that many of these would be privileged and work product. This was one of the grounds for objecting" (A607).

Respondents in their brief in Appeal No. 17,391 admitted in the court below that they "objected to the production of its attorney-client and work product documents during the District Court proceedings, commencing with its first brief [filed July 21, 1966-A39-62] in opposition to Natta's Rule 34 motion through its written objections preceding the District Court's Final Order of May 16, 1968" (p. 1). Respondents also acknowledged to the court below that in the briefs on the *second* appeal, No. 16,997, "The 'Statement of Facts' of both parties did recognize that Standard *had filed* attorney-client and work product objections" (p. 10, n. 6) and that "on Appeal No. 16,997, the merits of Standard's objections were never raised or argued" (p. 2).[8]

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[8] In their brief in Appeal No. 16,997, respondents did state erroneously:

"... Standard further agreed to drop its previous objection to producing communications with its experts regarding their retention (A353-4).[5]

"5. Montecatini [petitioner] acknowledged that such communication need not include any 'work product or privileged documents'" (Appellees' Brief in Appeal No. 16,997, p. 10). (cont'd.)

In these premises respondents' work product and privilege claims were waived. Yet the Court of Appeals, although it asked the parties in its order of January 30, 1969, to discuss the respondents' waiver, avoided the issue completely, placing its summary disposition of Appeal No. 17,391 exclusively upon an "interpretation" of its mandate on the second appeal.

REASONS WHY THE WRIT SHOULD BE GRANTED

1. The decision below endorsing the district court's exception to the mandate in Appeal No. 16,997 is in conflict with the applicable decisions of this Court culminating in *Briggs* v. *Pennsylvania R. Co.*, 334 U.S. 304 (1948). In *Briggs* this Court stated:

> "In its earliest days this Court consistently held that an inferior court has no power or authority to deviate from the mandate issued by an appellate court. Himely v. Rose, 5 Cranch (US) 313, 3 L ed 111; The Santa Maria, 10 Wheat (US) 431, 6 L ed 359; Boyce v. Grundy, 9 Pet (US) 275, 9 L ed 127; Sibbald v. United States, 12 Pet (US) 488, 9 L ed 1167. The rule of these cases has been uniformly followed in later days; see, for example, Re Washington & G. R. Co., 140 US 91, 35 L ed 339, 11 S Ct 673; Ex parte Union S.B. Co. 178 US 317, 44 L ed 1084, 20 S Ct 904; Kansas City S.R. Co. v. Guardian Trust Co. 281 US 1, 74 L ed 659, 50 S Ct 194. Chief Justice Marshall applied the rule to interdict allowance of interest not provided for in the mandate, Himely v. Rose, 5 Cranch (US) 313, 3 L ed 111; Mr. Justice Story explained and affirmed the doctrine, The Santa Maria, 10 Wheat (US)

In our Reply Brief we exposed the error in this representation by respondents. We said:

> "It needs to be emphasized that Natta has never 'acknowledged' that *any* documents within the scope of its motion may be withheld on grounds of work product or privilege as Standard states (S. Br. 10, n. 5). The *very* statement of counsel said to support this misrepresentation makes it clear that '*all* documents required by the motion' were sought (A422). The Group II documents include all those which may have been withheld on that basis." (Appellants' Reply Brief in Appeal No. 16,997, p. 11, n. 12; partial emphasis in original.)

> 431, 6 L ed 359; Boyce v. Grundy, 9 Pet (US) 275, 9 L ed 127. We do not see how it can be questioned at this time. . . ." (334 U.S. at 306)

In *Briggs,* the specific issue was whether the appellate court properly struck out an award of interest by the district court for which the appellate mandate did not provide. On that issue this Court said:

> ". . . It is clear that the interest was in excess of the terms of the mandate and hence was wrongly included in the District Court's judgment and rightly stricken out by the Circuit Court of Appeals. The latter court's mandate made no provision for such interest and the trial court had no power to enter judgment for an amount different than directed. . . ." (334 U.S. at 306)

Similarly, in its opinion of December 19, 1968, which became a part of the mandate in Appeal No. 16,997, the court below held that all post-October 15, 1954 documents should be produced by respondents "if they are in the categories already sought by Natta". The court's mandate made "no provision for" the exception of documents for which respondent might assert a claim of work product or privilege and the "trial court had no power to enter judgment" that respondents "shall *not* be required to produce" a portion of the documents subject to that mandate.[9]

2. The need for review by this Court is accentuated by respondents' reliance, in Appeal No. 17,391, upon a plu-

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[9] The decision in Appeal No. 17,391 is, of course, also at odds with the many decisions of the lower federal courts, including the prior decisions of the court below which have respected the authority of *Briggs* and the principles on which it rests. See, *e.g.,* from the court below *Townsend* v. *Ogilvie,* 360 F. 2d 925 (7 Cir. 1966); *Bankers Life and Casualty Co.* v. *Bellanca Corp.,* 308 F. 2d 757 (7 Cir. 1962); *Lee* v. *Terminal Transport Co.,* 301 F. 2d 234 (7 Cir. 1962); and from courts in other circuits: *Noel* v. *United Aircraft Corp.,* 359 F. 2d 671 (3 Cir. 1966); *Poletti* v. *C.I.R.,* 351 F. 2d 345 (8 Cir. 1965); *United States* v. *Cato Brothers, Inc.,* 273 F. 2d 153 (4 Cir. 1959); *Federal Home Loan Bank of San Francisco* v. *Hall,* 225 F. 2d 349 (9 Cir. 1955); and *Reconstruction Finance Corp.* v. *Service Pipe Line Co.,* 206 F. 2d 814 (10 Cir. 1953).

rality of inapposite decisions of this Court, including *Sprague* v. *Ticonic National Bank,* 307 U.S. 161 (1939) which states that "... While a mandate is controlling as to matters within its compass, on the remand a lower court is free as to other issues". See also *Mutual Life Ins. Co.* v. *Hill,* 193 U.S. 551 (1904).

Since the court below announced no reasons for its decision in Appeal 17,391, the possibility must be recognized that respondents' arguments based on these and similar cases may have been persuasive. Review is in order to emphasize that these cases have no application to situations such as those presented by the case at bar—the consequence of a party's failure to timely press a claim being *waiver,* not "preservation" thereof.

3. The refusal of the court below to bind respondents by their waiver of work product and privilege claims conflicts with the applicable decisions of this Court, with the apposite decisions of other courts of appeal and with the lower court's own prior decisions.

As noted, respondents admitted below that they "objected to the production of its attorney-client and work product documents during the District Court proceedings, commencing with its first brief in opposition to Natta's Rule 34 motion through its written objections preceding the District Court's Final Order of May 16, 1968", and that "The 'Statement of Facts' of both parties" in Appeal No. 16,997 "did recognize that Standard had filed attorney-client and work product objections" and that "on Appeal No. 16,997, the merits of Standard's objections were never raised or argued" (Appellees' Brief in Appeal No. 17,391, pp. 1-2).

In *California* v. *Taylor,* 353 U.S. (1957) 553, this Court, affirming the court below, said:

> "In its briefs before this Court, California suggests that the collective-bargaining agreement is invalid because the Board of State Harbor Commissioners lacked

> authority to negotiate the contract, some of the terms of which are in conflict with the state civil service laws. The [Seventh Circuit] Court of Appeals, however, held that this contention had been waived because it was not briefed there by the State and not mentioned in the State's oral argument. We, accordingly, do not recognize this contention here. . . ." (353 U.S. 553, 556, n. 2)

In *NAACP* v. *Alabama,* 360 U.S. 240 1205 (1959), the State of Alabama, while before this Court, failed to raise any grounds in support of a contempt citation entered by the Supreme Court of Alabama against the NAACP, except the latter's refusal to produce copies of its membership lists. After reversal and remand to the Alabama court, the State belatedly reverted to other grounds in support of the contempt citation which had not been argued here. This Court held that these grounds had been waived.

In *General Finance Loan Co.* v. *General Loan Co.,* 163 F. 2d 709, 711 (8 Cir. 1947), the court said:

> "... It has long been a rule of federal appellate courts that points not briefed and argued [before them] in a civil case will generally be regarded as abandoned, requiring no consideration on appeal. [Citing cases, including *Whiting* v. *United States Bank,* 13 Pet. 6, 38 U.S. 6, 13; *I.T.S. Rubber Co.* v. *Essex Rubber Co.,* 272 U.S. 429, 432; *Eastman Kodak Co.* v. *Southern Photo Materials Co.,* 273 U.S. 359, 369]." (163 F. 2d at 711)

See also *Thornton* v. *Carter,* 109 F. 2d 316 (8 Cir. 1940) and *Southwestern Petroleum Corp.* v. *Udall,* 361 F. 2d 650 (10 Cir. 1966).

The court below, without explanation, refused to apply this long established "rule of the federal appellate courts".

4. Fundamental to our jurisprudence is the idea that there must be an end to litigation. The basic rule of *res judicata* is soundly based on this principle. Among its natural concomitants are the corollary rules that issues

not timely pressed are waived and that *nisi prius* courts are without discretion to tamper with the mandates of their courts of appeal. As this Court has said: "there would be no end to a suit if every obstinate litigant could, by repeated appeals, compel a court to listen to criticisms on their opinions. . .", *United States* v. *Camou,* 184 U.S. 572, 574 (1902).

These considerations are particularly cogent today when understaffed courts are attempting to deal with an unprecedented mass of litigation. Under such circumstances the departure of the court below from established procedures to tolerate respondents' abandoned work product and privilege claims warrants the exercise of the supervisory authority of this Court.

It would be hard to imagine a case where the exercise of that authority to preclude the unnecessary prolongation of litigation would be more appropriate. In its first opinion in this case the court below correctly held that 35 U.S.C. 24 vested in the federal district courts an "ancillary jurisdiction—a jurisdiction designed to cooperatively complement Patent Office jurisdiction as an aid to the quest for truth". *Natta* v. *Zletz,* 379 F. 2d 615, 618 (7 Cir. 1967) cited and quoted *Natta* v. *Hogan,* 392 F. 2d 686, 691 (10 Cir. 1968). In its second opinion, while again emphasizing "the public interest in seeking the truth about who is entitled to this patent", the court below, acknowledging another important aspect of its "cooperative" jurisdiction, directed "counsel for both sides" to endeavor "to complete this overdue discovery with dispatch, thus enabling the Board of Patent Interferences to dispose of this matter without further ancillary delays" (405 F. 2d 99, 102; A597). Yet the court below seemingly overlooked this aspect of the matter in disposing of Appeal No. 17,391. It simply failed to recognize for what it is respondents' conduct pattern of premeditated obstructionism.

When it is remembered that Interference 89,634 has been pending in the Patent Office for more than ten years, the proper exercise of "cooperative" jurisdiction with the

Patent Office does not contemplate a relaxation for respondents' benefit of the rules of law which should have put an end to this litigation with the second appeal. Particularly so when the enforcement of these rules would further aid the "quest for truth" by releasing from secrecy the mass of materials which respondents still withhold.

CONCLUSION

Having regard to the clear error in the decision below, it is respectfully requested that this petition be granted and that a summary reversal be concurrently ordered so that the disposition of Interference 89,634 will not be further delayed.

Respectfully submitted,

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APPENDIX

STATUTES AND REGULATIONS INVOLVED

28 U.S.C.

Section 1254. Court of appeals; certiorari; appeal; certified questions.

Cases in the court of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

* * * * * *

35 U.S.C.

Section 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

* * * * * *

Section 135. Interferences

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

* * * * * *

FINAL ORDER AFTER REMAND ENTERED JANUARY 21, 1969, NUNC PRO TUNC JANUARY 17, 1969

WHEREAS, this Court by its Minute Order dated July 18, 1967 "allowed" the "motion of party Natta et al for discovery under Rule 34" "subject to objections as they shall be made from time to time"; and

WHEREAS, this Court by its Final Order dated May 16, 1968 sustained the objections thereafter advanced by defendants Alex Zletz and Standard Oil of Indiana (hereinafter collectively referred to as "Standard") to the aforesaid motion of Natta et al; and

WHEREAS, Natta et al duly appealed from the said Final Order dated May 16, 1968; and

WHEREAS, the United States Court of Appeals for the Seventh Circuit on December 19, 1968 rendered an opinion on said appeal stating, *inter alia:*

(a) that it "set aside" this Court's Final Order dated May 16, 1968 "as unduly restrictive and not in accord with the broad type of discovery and duty of full disclosure contemplated by the patent laws, including 35 U.S.C. § 24" (p. 2);

(b) that the "Documents assertedly relating to polyethylene rather than polypropylene" which "were inspected *in camera* and *ex parte* by the district judge" (p. 2), later identified in said opinion as "the polyethylene documents" (p. 3), "are relevant or may lead to relevant matters within the purview of Rules 26(b) and 34 of the Federal Rules of Civil Procedure" "and may not be withheld on the grounds of irrelevancy" (p. 3);

(c) that as to Standard's claim that "the polyethylene documents" " 'constitute valuable trade secrets' " (p. 3) "Standard has no absolute right to refuse to divulge the polyethylene information on trade secrecy grounds in view of the public interest in seeking the truth about who is entitled to this patent", "that any prejudice to the owner of trade secrets caused by disclosure under Rule 34 could be obviated by a protective order under Rule 30(b)", that "Therefore, it is our conclusion that Natta's counsel may inspect the polyethylene documents submitted to the district court in envelopes II, III and V subject to the protective order entered by the district court on September 14, 1967, to be supplemented by a

district court clause specifically forbidding Natta's counsel to make any disclosure to Natta, its assignees, or any third parties. Under the protective order, the information disclosed may only be used in Interference 89,634", that "Natta counsel may not disclose any information derived from this inspection outside the Patent Office", and that "During the presentation of Natta's rebuttal case before the Patent Office, Standard can secure further protection against any revelation of its trade secrets" (p. 4);

(d) that the "Two Standard memoranda dealing with the possible filing of foreign patent applications . . . also withheld by the district court on relevancy grounds . . . are sufficiently relevant to compel inspection" (pp. 4-5); and

(e) that "the district court selected October 15, 1954, the date of Zletz's application, as the cut-off date for discovery"; "the cut-off date selected was improper. Subsequent documents may bear on events prior thereto and also on any actual reduction to practice by Standard. They should be produced if they are in the categories already sought by Natta" (p. 5); and

WHEREAS, this Court on January 14, 1969 received the mandate of the Court of Appeals pursuant to which this Court's Final Order of May 16, 1968 was reversed and this cause was remanded to this Court for further proceedings not inconsistent with the appellate opinion;

NOW, THEREFORE,

It is hereby ORDERED that

A. This Court's Final Order dated May 16, 1968 is hereby vacated and the Natta et al motion for discovery under Rule 34 is granted;

B. To the extent it has not already done so, Standard shall produce for inspection by Natta counsel all of the documents with respect to which Standard's objections were sustained by said hereby vacated Final Order, subject only to the terms and conditions set forth in the aforementioned opinion of the United States Court of Appeals for the Seventh Circuit and paragraph D hereof;

C. Specifically, but only by way of elucidation and not in limitation of the foregoing paragraphs A and B hereof, Standard shall produce for inspection by counsel for Natta et al:

(1) the so-called "polyethylene documents" provided however,

(a) that those of the polyethylene documents which are contained in the envelopes heretofore submitted to this Court and identified as envelopes 1, 1(a), 1(b), 1(c), 2, 3 and 4 shall be produced subject to the existing protective order entered by this Court on September 14, 1967, and

(b) that those of the polyethylene documents submitted to the district court in envelopes II, III and V shall be produced subject to the protective order entered by this Court on September 14, 1967 as hereby supplemented pursuant to the mandate of the Court of Appeals

(i) to forbid Natta counsel from making any disclosure of the information derived from this inspection to Natta, its assignees or any third parties,

(ii) to provide that the information disclosed may only be used in Interference 89,634,

(iii) to provide that Natta counsel may not disclose any information derived from this inspection outside the Patent Office, and

(iv) to provide that during the presentation of Natta's rebuttal case before the Patent Office Standard may apply to the Patent Office for further protection against any revelation of its trade secrets.

(2) The "Two Standard memoranda dealing with the possible filing of foreign patent applications", the same being the "Memo '8-3-54 DEP' " and the "Memo '2-1-54' " identified in paragraph 3 of the said Final Order of May 16, 1968, and

(3) all documents dated subsequent to October 15, 1954, in the categories already sought by Natta.

D. Notwithstanding anything in the prior provisions of this Order, Standard shall not be required to produce documents constituting or disclosing confidential communications between Standard the client and counsel for Standard and relating to the seeking of, or giving of, legal advice of any kind, nor shall counsel for Standard be required to submit to Natta or its counsel any documents in the nature of attorney's work product developed in anticipation of Interference 89,634 or in anticipation of these proceedings.

JAMES B. PARSONS,
United States District Judge.

UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604

March 10, 1969

Before Hon. LATHAM CASTLE, Chief Judge, Hon. WIN G. KNOCH, Senior Circuit Judge, Hon. WALTER J. CUMMINGS, Circuit Judge.

No. 17391

GIULIO NATTA, et al., *Appellants,*

vs.

ALEX ZLETZ, et al., *Appellees.*

ORDER

The principal question presented by this appeal is whether our mandate of January 14, 1969, following the issuance of our opinion reported in 405 F. 2d 99, precluded the district court from entering an order excepting from appellant Natta's documentary inspection appellee Standard's attorneys' work product and confidential communications between them and Standard with respect to certain legal advice.

Upon consideration of the briefs and the appendix, the district court's order of January 21, 1969, is affirmed, but without prejudice to Natta's contesting Standard's work product and privilege claims on the merits before the district court.

It is further ordered that Standard's motion for leave to file a summary list of privileged documents in this Court is denied.

IN THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION

Civil Action No. 66 C 1211

HOGAN, et al.

v.

ZLETZ,

v.

BAXTER, et al.

v.

NATTA, et al.

LIST OF STANDARD'S PRIVILEGED DOCUMENTS

For convenience of reference, this list of documents as to which Standard Oil Company and Zletz assert the attorney-client and/or work product privileges is divided into three general categories:

Category 1 lists correspondence between outside counsel retained by Standard and Zletz in connection with or in anticipation of Interference 89,634 and attorneys in the Patents and Licensing Department of Standard (including subsidiaries).

Category 2 lists intra-office memoranda prepared either by such outside counsel or by attorneys in Standard's Patents and Licensing Department in connection with their work on Interference 89,634.

Category 3 lists correspondence between Standard's outside counsel and one of its outside technical experts in connection with Interference 89,634.

The documents in each category are listed in chronological order and each document is described by an identifying number, by the type of document involved, by author(s) and addressee(s) [1] including job title, and by a description of the document's contents. In order to avoid revealing

[1] Includes all persons shown to have received a carbon copy of the document or to whom the original is shown to have been circulated, other than the secretary charged with filing the document.

the privileged information involved, the latter description is necessarily quite brief.[2] The full job title or position of an author or addressee is given only the first time such person appears in this list and is omitted thereafter to avoid unnecessary repetition.

Excluded from this list are correspondence and intra-office memoranda relating to the drafting of motions or other papers to be filed by Standard and Zletz in Interference 89,634 or relating to papers filed or the testimony given by the other parties to the Interference. Although technically covered by a liberal reading of certain paragraphs of the Natta Rule 34 Motion, it is assumed that the production of such documents is not in fact requested. It should be noted in this connection that the correspondence, drafts and other documents relating to the affidavits filed in connection with the Zletz applications referred to in Paragraph 23 of the Natta Motion have been produced where available.

[2] To the extent even this brief description may disclose any of the substance of the privileged material, it is in no sense intended as a waiver of such privilege by Standard.

CATEGORY 1 (Page 1 of 5)

Correspondence between Outside Counsel retained by Standard and Zletz in connection with or in anticipation of Interference 89,634 and Attorneys in the Patents and Licensing Department of Standard (including subsidiaries.)

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
5/29/56 Letter 14700	S. B. Becker, Esq., Standard Senior Patent Attorney	B. B. Schneider, Esq.,[1] Schneider & Bressler Chicago, Illinois cc: P. H. Sullivan, Esq. Standard General Patent Attorney E. L. d'Ouville Standard Director Technical Liaison	Forwards documents for use by Mr. Schneider in evaluating Standard's patent position in anticipated Interference 89,634.
5/31/56 Letter 05144–05146	S. B. Becker, Esq.	B. B. Schneider, Esq. cc: P. H. Sullivan, Esq. E. L. d'Ouville	Summarizes conference with Mr. Schneider regarding his evaluation of Standard's patent position in anticipated Interference 89,634.
8/7/58 Letter 14704	A. G. Gilkes, Esq., Standard General Patent Attorney	J. T. Kelton, Esq., Watson, Leavenworth, Kelton & Taggart, New York, N.Y. cc: S. B. Becker, Esq. S. Kahn, Esq., Standard Senior Patent Attorney E. L. d'Ouville	Discusses matters to be reviewed at conference with Mr. Kelton in anticipation of his work on Interference 89,634.

[1] Mr. Schneider, who was initially retained as outside counsel, is deceased and was succeeded by Mr. Kelton (see later).

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
8/8/58 Letter 14705	J. T. Kelton, Esq.	A. G. Gilkes, Esq. cc: P. H. Sullivan, Esq. S. B. Becker, Esq. S. Kahn, Esq. D. E. Payne, Esq. Standard Assistant General Patent Attorney	Response to above letter.
8/15/58 Letter and Charts 14706 (group document)	S. Kahn, Esq.	J. T. Kelton, Esq.	Forwards charts used during above conference.
8/18/58 Letter 14707	J. T. Kelton, Esq.	A. G. Gilkes, Esq. cc: P. H. Sullivan, Esq. D. E. Payne, Esq. S. Kahn, Esq. S. B. Becker, Esq. E. L. d'Ouville P. C. White Vice President, Research and Development, American Oil Company R. Gottschalk, Esq. Assistant Manager, Patents and Licensing Department	Comments on above conference.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
8/25/58 Letter 05078–05084	S. B. Becker, Esq.	J. T. Kelton, Esq.	Summarizes and comments on above conference.
8/27/58 Letter 14708 and Memo 05074–05077	S. Kahn, Esq.	J. T. Kelton, Esq. cc: P. H. Sullivan, Esq. A. G. Gilkes, Esq. D. E. Payne, Esq. S. B. Becker, Esq. E. L. d'Ouville	Forwards memorandum of Mr. Kahn summarizing and commenting on above conference.
1/5/58(9) [4] Letter 14701	S. Kahn, Esq.	J. T. Kelton, Esq. cc: A. G. Gilkes, Esq. D. E. Payne, Esq.	Inquires re legal effect of publication of British equivalent to U. S. application in anticipated Interference 89,634.
1/8/59 Letter 14702–14703	J. T. Kelton, Esq.	S. Kahn, Esq. cc: A. G. Gilkes, Esq. P. H. Sullivan, Esq. D. E. Payne, Esq. E. L. d'Ouville	Response to above letter.
7/8/59 Letter 14709	S. Kahn, Esq.	J. T. Kelton, Esq.	Summarizes and comments on information supplied for use by Mr. Kelton in Interference 89,634.
9/24/59 Letter 14710	A. G. Gilkes, Esq.	J. T. Kelton, Esq.	Requests legal opinion on involvement of other patent application in Interference 89,634.

[4] Document misdated as 1/5/58; should be 1/5/59.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
9/29/59 Letter 14711–14714	J. T. Kelton, Esq.	A. G. Gilkes, Esq. cc: S. Kahn, Esq. A. H. Bransky, Esq. Standard Assistant General Patent Attorney	Response to above letter.
10/16/59 Letter 14715	A. G. Gilkes, Esq.	J. T. Kelton, Esq.	Comments on Mr. Kelton's 9/24/59 Letter.
10/29/59 Letter 14716–14717	J. T. Kelton, Esq.	A. G. Gilkes, Esq. cc: S. Kahn, Esq. A. H. Bransky, Esq.	Discusses legal significance to Interference 89,634 of certain technical data and requests further information.
11/30/59 Letter 14718	S. Kahn, Esq.	J. T. Kelton, Esq. cc: A. G. Gilkes, Esq. E. L. d'Ouville P. Hill, Standard Senior Patent Advisor	Comments on further information requested by Mr. Kelton's 10/29/59 letter.
5/4/60 Letter 14719	A. G. Gilkes, Esq.	J. T. Kelton, Esq. cc: A. H. Bransky, Esq. S. Kahn, Esq.	Comments further on matter raised in letters of 9/24/59, 9/29/59 and 10/16/59.
1/25/61 Letter 14720–14721	J. T. Kelton, Esq.	P. H. Sullivan, Esq.	Legal opinion concerning the Standard and Zletz case in Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
6/16/65 Letter and Affidavit 14722–14724	A. G. Gilkes, Esq.	J .T. Kelton, Esq.	Discusses use of possible witness in Interference 89,634 and comments on witness' enclosed affidavit.
6/17/68 Letter 14725	J. T. Kelton, Esq.	A. G. Gilkes, Esq. cc: A. H. Bransky, Esq. R. C. Medhurst, Esq. Standard Senior Patent Attorney E. L. d'Ouville	Legal advice in response to above letter.

Intra-office memoranda prepared either by Standard's Outside Counsel or by Attorneys in Standard's Patents and Licensing Department in connection with their work in Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
2/9/59 Memorandum 14726–14727	S. Kahn, Esq.	File cc: P. H. Sullivan, Esq. A. G. Gilkes, Esq. A. H. Bransky, Esq. D. E. Payne, Esq. E. L. d'Ouville P. Hill	Summarizes conference relating to preparation of case in Interference 89,634.
5/13/59 *Memorandum 14741	J. T. Kelton, Esq.	File	Summarizes and comments on conference with Standard Patent Department attorneys regarding claims involved in Interference 89,634.
5/13/59 *Memorandum 14742	J. T. Kelton, Esq.	File	Continuation of above.
2/23/60 *Memorandum 14743	W. H. Vogt, Esq., Watson, Leavenworth, Kelton & Taggart 100 Park Avenue New York, N. Y.	J. T. Kelton, Esq.	Comments on matters to be discussed with Standard attorneys and outside consultant in connection with Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
4/5/60 *Memorandum 14744	J. T. Kelton, Esq.	File	Summarizes and comments on conference with Standard Patent Department attorney concerning certain aspects of Natta case in Interference 89,634.
4/7/61 Memorandum 14728	D. G. Brace, Esq.	A. G. Gilkes, Esq. cc: A. H. Bransky, Esq. S. Kahn, Esq. W. T. McClain, Esq. Standard Senior Patent Attorney	Summarizes legal research in connection with Interference 89,634.
12/5/61 Memorandum 14729–14730	D. G. Brace, Esq.	File	Summarizes legal research in connection with Interference 89,634.
2/23/62 Memorandum 14731	D. G. Brace, Esq.	File cc: J. T. Kelton, Esq. A. G. Gilkes, Esq. R. C. Medhurst, Esq.	Summarizes and comments on technical information in connection with Interference 89,634.
6/11/63 *Memorandum 14745	W. H. Vogt, Esq.	J. T. Kelton, Esq.	Summarizes and comments on published article having possible application to Interference 89,634.
9/4/64 *Memorandum 14746	W. H. Vogt, Esq.	J. T. Kelton, Esq.	Summarizes telephone conversation with Standard Patent Department attorney concerning meeting with Standard technical expert in Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
10/12/64 Handwritten Notes 14732	R. C. Medhurst, Esq.	File	Summarizes and comments on anticipated testimony in Interference 89,634.
10/21/64 Memorandum 14734	R. C. Medhurst, Esq.	A. G. Gilkes, Esq.	Summarizes telephone request by Mr. Kelton for information in connection with Interference 89,634.
8/27/64 *Memorandum 14749 (group document)	D. Dick, Esq.[5] Watson, Leavenworth, Kelton & Taggart	File	Summarizes and comments in connection with Interference 89,634 on prior availability of Standard applications to DuPont.
9/8/64 *Memorandum 14750 (group document)	D. Dick, Esq.	File	Tabulates and comments on laboratory notebooks in connection with Interference 89,634.
9/11/64 *Memorandum 14751 (group document)	D. Dick, Esq.	File	Discusses additional proofs to be sought in Interference 89,634.
9/14/64 *Memorandum 14752 (group document)	D. Dick, Esq.	File	Summarizes and comments on laboratory notebooks in connection with Interference 89,634.

[5] Mr. Dick was first associated with the firm of Watson, Leavenworth, Kelton & Taggart on April 1, 1963 as a law clerk. While so employed, Mr. Dick worked under the direct and immediate supervision of J. T. Kelton, Esq. in connection with Interference 89,634. Mr. Dick was admitted to the bar of New York on March 17, 1965.

Document Date, Type and* Identifying No.	Author(s)	Addressee(s)	Summary Description
10/2/64 *Memorandum 14753 (group document)	D. Dick, Esq.	File	Summarizes and comments on chronology of events reported in laboratory notebooks in connection with Interference 89,634.
10/20/64 *Memorandum 14754 (group document)	D. Dick, Esq.	W. H. Vogt, Esq.	Summarizes and comments on evidence relating to fibers in connection with Interference 89,634.
1/26/65 *Memorandum 14755 (group document)	D. Dick, Esq.	File	Summarizes and comments on preparation for testimony in Interference 89,634.
1/27/65 *Memorandum 14756 (group document)	D. Dick, Esq.	File	Summarizes and comments on certain laboratory records relating to Interference 89,634.
2/2/65 *Memorandum 14757 (group document)	D. Dick, Esq.	File	Summarizes and comments on certain laboratory records relating to Interference 89,634.
2/5/65 *Memorandum 14758 (group document)	D. Dick, Esq.	File	Summarizes and comments on past analytical techniques relating to Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
2/5/65 *Memorandum 14759 (group document)	D. Dick, Esq.	File	Summarizes and comments on past analytical techniques relating to Interference 89,634.
2/18/65 *Memorandum 14760 (group document)	D. Dick, Esq.	File	Summarizes and comments on past analytical techniques relating to Interference 89,634.

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Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
4/26/65 *Memorandum 14761	Stevan Bosses, Esq. Watson, Leavenworth, Kelton & Taggart	D. Dick, Esq.	Summarizes legal research in connection with Interference 89,634.
5/11/65 Handwritten Notes 14735	A. G. Gilkes, Esq.	File	Summarizes and comments on interview with possible witness in Interference 89,634.
7/12/65 *Memorandum 14762 (group document)	D. Dick, Esq.	File	Summarizes and comments on Standard claims in Interference 89,634.
7/13/65 *Memorandum 14782 (group document)	D. Dick, Esq.	File	Summarizes and comments in connection with Interfeernce 89,634 on activities of outside technical expert.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
7/15/65 *Memorandum 14763 (group document)	D. Dick, Esq.	File	Summarizes and comments on certain laboratory records relating to Interference 89,634.
8/4/65 *Memorandum 14764 (group document)	D. Dick, Esq.	File	Summarizes and comments on certain laboratory records relating to Interference 89,634.
9/13/65 Memorandum 14736	R. C. Medhurst, Esq.	File	Summarizes and comments on interview with possible witness in Interference 89,634.
12/2/65 *Memorandum 14783 (group document)	W. H. Vogt, Esq.	File	Summarizes legal research in connection with Interference 89,634.
12/7/65 *Memorandum 14765	S. Bosses, Esq.	W. H. Vogt, Esq.	Summarizes legal research in connection with Interference 89,634.

CATEGORY 2 (Page 6 of 7)

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
12/8/65 *Memorandum 14766	S. Bosses, Esq.	W. H. Vogt, Esq.	Summarizes legal research in connection with Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
1/15/66 *Memorandum 14780	J. T. Kelton, Esq.	File	Comments on telephone conference with outside expert in connection with Interference 89,634.
6/15/66 *Memorandum 14767 (group document)	H. J. Bridger,[6] Watson, Leavenworth, Kelton & Taggart	File	Summarizes and comments on testimony of certain witnesses in Interference 89,634.
Undated *13 Notebooks 1 File Folder 14768 (group document)	J. T. Kelton, Esq.	File	Personal notes summarizing and commenting on testimony and personal notes and material for examination of witnesses in Interference 89,634.
Undated *3 Notebooks 1 File Folder 14769 (group document)	W. H. Vogt, Esq.	File	Personal notes summarizing and commenting on testimony in Interference 89,634.
Undated 2 Notebooks 1 File Folder 14738 (group document)	A. G. Gilkes, Esq.	File	Personal notes summarizing and commenting on testimony in Interference 89,634.

[6] Mr. Bridger became associated with the firm of Watson, Leavenworth, Kelton & Taggart on May 16, 1966 as a law clerk. While so employed, Mr. Bridger worked under the direct and immediate supervision of J. T. Kelton, Esq. in connection with Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
Undated 12 File Folders 14739 (group document)	R. C. Medhurst, Esq.	File	Personal notes summarizing and commenting on testimony in Interference 89,634.

CATEGORY 2 (Page 7 of 7)

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
Undated 5 Notebooks 3 File Folders 14740 (group document)	J. G. Blumberg, Esq. Standard Patent Attorney	File	Personal notes summarizing and commenting on testimony in Interferenec 89,634.
Undated Notebook 14737 (group document)	S. Kahn, Esq.	File	Personal notes in connection with preparation for Interference 89,634.
Undated *Memorandum 14747 (group document)	D. Dick, Esq.	File	Summarizes and comments on certain aspects of Standard case relating to Interference 89,634.
Undated *Memorandum 14748 (group document)	D. Dick, Esq.	File	Summarizes and comments on certain laboratory records relating to Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
Undated *18 Notebooks 14781 (group document)	D. Dick, Esq.	File	Personal notes summarizing and commenting on testimony in Interference 89,634.

CATEGORY 3 (Page 1 of 1)

Correspondence between Standard's Outside Counsel and one of its outside technical experts in connection with Interference 89,634.

Document Date, Type and Identifying No.	Author(s)	Addressee(s)	Summary Description
11/29/65 Letter 14777	Dr. H. F. Mark Professor Emeritus Polytechnic Institute of Brooklyn, Brooklyn, N. Y.	J. T. Kelton, Esq. cc: R. C. Medhurst, Esq.	Discusses technical information requested by Mr. Kelton in connection with Interference 89,634.
12/1/65 Letter 14778	J. T. Kelton, Esq.	Dr. H. F. Mark cc: A. G. Gilkes, Esq.	Requests clarification of one item in above letter.
12/6/65 Letter and Diagrams 14779	Dr. H. F. Mark	J. T. Kelton, Esq.	Supplies further technical information requested by Mr. Kelton in connection with Interference 89,634.

UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604

January 22, 1969.

Before Hon. LATHAM CASTLE, Chief Judge, Hon. WIN G. KNOCH, Senior Circuit Judge, Hon. WALTER J. CUMMINGS, Circuit Judge.

No. 17371

GIULIO NATTA, PIERO PINO and GIORGIO MAZZANTI, *Petitioners,*

vs.

HON. JAMES B. PARSONS, District Judge, *Respondent.*

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

This matter comes before the Court on the petition of Giulio Natta, Piero Pino and Giorgio Mazzanti, "that this Court issue a writ of mandamus and prohibition, directed to the Honorable James B. Parsons, (a) commanding (i) the entry of a final order in C. A. 66 C 1221 effective to enforce said mandate without deviation and (ii) vacation of any and all previously entered orders not in accord with said mandate, and (b) prohibiting the entry of any order which deviates from said mandate." On consideration whereof,

IT IS ORDERED AND ADJUDGED by this Court that the said petition of Giulio Natta, Piero Pino and Giorgio Mazzanti, be and the same is hereby denied.

A True Copy:

Teste:

KENNETH J. CARRICK
Clerk of the United States Court of Appeals for the Seventh Circuit

UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604

January 30, 1969.

Before Hon. LATHAM CASTLE, Chief Judge, Hon. WIN G. KNOCH, Senior Circuit Judge, Hon. WALTER J. CUMMINGS, Circuit Judge.

No. 17391

GIULIO NATTA, et al., *Appellants,*

vs.

ALEX ZLETZ, et al., *Appellees.*

ORDER

On consideration of the appellants' motion to suspend rules and to expedite the decision,

IT IS ORDERED that appellants' brief shall be filed on or before February 3, 1969, appellees' brief shall be filed on or before February 17, 1969, and appellants' reply brief shall be filed within 7 days thereafter. In their briefs, the parties are requested to discuss, *inter alia,* whether appellees have waived the attorney-client and work product privileges specified in paragraph D of the district court's order of January 21, 1969, by failure to raise the issue in Appeal No. 16997, or for other reasons. After the aforesaid briefs are filed with the Clerk of this Court, the cause will be taken under advisement without any oral argument. Exhibits A and C in the Exhibit Book in Appeal No. 17371 shall be deemed a part of the record in this appeal, and the 2-volume appendix in Appeal No. 16997 will be deemed Volumes I and II of the appendix herein.

UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604

April 7, 1969.

Before Hon. LATHAM CASTLE, Chief Judge, Hon. WIN G. KNOCH, Senior Circuit Judge, Hon. WALTER J. CUMMINGS, Circuit Judge.

No. 17391

GIULIO NATTA, et al., *Appellants,*

vs.

ALEX ZLETZ, et al., *Appellees.*

On consideration of the petition of the appellants, Giulio Natta, et al., for a rehearing by the Court en banc in the above-entitled appeal, and, no member of the panel and no judge in regular active service having requested that a vote be taken on the suggestion for an en banc rehearing, and the panel having voted to deny a rehearing,

IT IS ORDERED that the petition of the appellants for a rehearing in the above-entitled appeal be, and the same is hereby denied.

(6959-1)

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 1346

GIULIO NATTA ET AL.,

Petitioners,

vs.

ALEX ZLETZ and STANDARD OIL COMPANY,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

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BRIEF FOR RESPONDENTS IN OPPOSITION

HAMMOND E. CHAFFETZ
WILLIAM R. JENTES
ELSIE C. SPEARS

KIRKLAND, ELLIS, HODSON,
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Attorneys for Respondents.

TWENTIETH CENTURY PRESS, INC., CHICAGO 60605

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 1346

GIULIO NATTA ET AL.,

Petitioners,

vs.

ALEX ZLETZ and STANDARD OIL COMPANY,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

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BRIEF FOR RESPONDENTS IN OPPOSITION

Question Presented

Whether the court of appeals correctly construed its own opinion and mandate in an earlier appeal in this case as preserving respondents' attorney-client and work product objections to petitioners' motion for the production of documents.

Statement of the Case

Petitioners Natta et al. and respondent Zletz are two of the four parties to an interference proceeding now pending

before the United States Patent Office. Pursuant to 35 U.S.C. § 24, which authorizes resort to the district courts for discovery ancillary to such a proceeding, petitioners filed a motion in the Northern District of Illinois asking for the production under F.R.C.P. 34 of 26 categories of documents from the files of respondent Zletz and the assignee of his patent application, respondent Standard Oil Company (Indiana) (A 1-15).[1] The district court's initial dismissal of the motion on jurisdictional grounds not relevant here was reversed by the Seventh Circuit in its opinion and order of June 19, 1967 (reported in 379 F.2d 615) and the cause was remanded to the district court to consider petitioners' motion on its merits (A 166).

Following remand, respondents agreed to supply the major part of petitioners' documentary requests. Of the limited objections which respondents pressed to certain portions of the motion, only two are relevant here. First, respondents objected to the production of documents dated after the October 15, 1954 filing of the Zletz patent application involved in the interference on the ground that such documents were unduly remote to the issues to be decided in that proceeding and, therefore, "not within the proper scope of discovery ancillary to said interference" (A 539). Second, respondents objected on the ground that "many of said documents [*i.e.*, those post-dating October 15, 1954] represent work product and are privileged" (*ibid*).[2]

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1. References to "(A.....)" are to the appendix below.

2. As the petition recognizes, respondents emphasized their privilege objections throughout the district court proceedings, "commencing with [their] first brief in opposition to Natta's Rule 34 motion through [their] written objections preceding the District Court's Final Order of May 16, 1968." (Pet., p. 12.)

The district court, in its order of May 16, 1968, sustained the first of these objections and imposed a discovery "cut-off" of October 15, 1954 (A 579-81). That ruling, applying as it did to all documents prepared after that date, made it unnecessary for the court to reach respondents' objection that certain of those documents were also protected from discovery by reason of the attorney-client and work product privileges. Petitioners took no exception at that time to the trial court's failure to pass on the privilege issue in its May 16, 1968 order.

When the proceeding again reached the court of appeals on petitioners' second appeal, the only issue to which that court or the parties addressed themselves was the correctness of the October 15, 1954 "cut-off" imposed by the district court. On that issue, the court of appeals reversed, concluding in its decision and opinion of December 19, 1968 (reported in 405 F.2d 99):

> "Since it is well settled that events following the date of a patent application may cast doubt on the patentability of the product [citations omitted], the cut-off date selected was improper. Subsequent documents may bear on events prior thereto and also on any actual reduction to practice by Standard. They should be produced if they are in the categories already sought by Natta." (A 596-7.)

Respondents' right to assert the attorney-client and work product privileges as to any of the documents in the post-October 15, 1954 period was nowhere mentioned among the "contested issues" in either parties' brief; it was not touched on in oral argument; and it received only a single footnote reference in the court's opinion, which observed:

> "Rule 34, the documentary inspection rule, incorporates Rule 26(b) by reference. That rule permits discovery as to any *unprivileged matter*, even if inadmissible, as

long as it is relevant or 'reasonably calculated to lead to the discovery of admissible evidence.'" (A 594; emphasis added.)

The mandate of the court of appeals issued on January 14, 1969 (A 598), and at a hearing before the district court on January 17, 1969 to settle the appropriate order following remand, respondents duly renewed their privilege objections (A 604-9). The district court indicated during this hearing that it intended to exclude privileged documents from discovery (A 610), and its written order of January 21, 1969 provided in pertinent part that respondents "shall not be required to produce documents constituting or disclosing confidential communications between Standard the client and counsel for Standard and relating to the seeking of, or giving of, legal advice of any kind, nor shall counsel for Standard be required to submit to Natta or its counsel any documents in the nature of attorney's work product developed in anticipation of Interference 89,634" (A 628).[3]

One day before the entry of this order, petitioners filed a petition for writ of mandamus and prohibition with the court of appeals contending, as here, that any order by the district court excluding respondents' privileged documents from production was assertedly contrary to the direction of the court of appeals that all documents dated subsequent to October 15, 1954 "should be produced if they are in the categories already sought by Natta" (A 597). The court of appeals summarily denied the mandamus petition on January 22, 1969 (Pet., p. 23a). Petitioners thereupon took

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3. This order did not, as the petition asserts, give respondents the right *"to judge for themselves"* the merits of their work product and privilege claims (Pet., p. 8; emphasis in original). As the petition elsewhere recognizes (p. 5, n. 2), the district court is presently considering respondents' privilege claims as to individual documents based on an *in camera* review of such documents.

a third appeal to the court of appeals. In a brief *per curiam* order of March 10, 1969, the court of appeals affirmed the district court (*id.* at 5a). Petitioners' request for rehearing *en banc* was denied on April 7, 1969 (*id.* at 25a), and the matter is now before this court on the petition for writ of certiorari filed April 25, 1969.

Reasons for Denying the Writ

1. As petitioners implicitly recognize (Pet., pp. 8, 10), the real question presented here is whether this Court should disturb a decision by the court of appeals interpreting its own opinion and mandate on a prior appeal in this case. For if, as the court of appeals concluded, it did not pass on respondents' privilege objections when the case was before that court last Fall, the district court was free to consider those objections following remand and there is no basis for issuing the requested writ.

This Court has repeatedly recognized that "the court that issues a mandate is normally the best judge of its content, on the general theory that the author of a document is ordinarily the authoritative interpreter of its purposes." *F.C.C.* v. *Pottsville Broadcasting Co.*, 309 U.S. 134, 141 (1940). See also, *N.L.R.B.* v. *Donnelly Co.*, 330 U.S. 219, 227 (1947); *F.T.C.* v. *Colgate-Palmolive Co.*, 380 U.S. 374, 379 (1965). While such an interpretation has occasionally been overturned, this has occurred only where some "deeper issue" has been involved, such as the matter of Congressional and administrative policy presented by those cases. Here, no such issue of overriding public concern is posed, and even the purely private dispute presented by the petition raises no consequential, let alone substantial question for review.

2. Thus, petitioners' argument (Pet., pp. 10, 11), based on *Briggs* v. *Pennsylvania R. Co.*, 334 U.S. 304, 306 (1948),

that the court of appeals erred in allowing the trial court to entertain respondents' privilege objections because "an inferior court has no power or authority to deviate from the mandate issued by an appellate court," ignores this Court's observation in *Sprague* v. *Ticonic Bank*, 307 U.S. 161, 168 (1939), that this "leaves us still to consider whether the immediate issue now in controversy was disposed of in the main litigation and therefor foreclosed by the mandate. While a mandate is controlling as to matters within its compass, on the remand a lower court is free as to other issues."

In deciding whether "the immediate issue now in controversy" was in fact disposed of by a prior appeal, it has consistently been held that a judgment of reversal (which was the case here) constitutes an adjudication by the appellate court *only* of the "questions in terms discussed and decided" on the earlier appeal. *Mutual Life Insurance Co.* v. *Hill*, 193 U.S. 551, 554 (1904). See also, *General Inv. Co.* v. *Lake Shore Ry.*, 260 U.S. 261, 285 (1922); *Wolff Packing Co.* v. *Indus. Court*, 267 U.S. 552, 562 (1925). As is readily apparent from a reading of the court of appeals' December 19, 1968 opinion and January 14, 1969 mandate, that court did not discuss or decide whether respondents were entitled to the protection of the attorney-client and work product privileges.[4] Consequently, petitioners' objections were not within the compass of the court's mandate and they remained extant for consideration by the district court on remand.

3. Petitioners' alternative argument (Pet., pp. 12, 13) that respondents "waived" their privilege objections by

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4. To the extent the court of appeals expressed any views on respondents' privilege claims, its footnote observation that Rule 34 permits discovery only as to "any unprivileged matter" (A 594) seems to indicate it believed respondents' claims should be sustained.

failing to raise those objections on the prior appeal is equally without merit. Petitioners overlook that there was no reason or basis for respondents to press their objections at that time. Since the district court's May 16, 1968 order had sustained respondents' objection to the production of *all* post-October 15, 1954 documents on the ground that they were unrelated to the issues in the interference proceeding, that court was not required to reach the question of whether some of those documents were also protected from discovery on privilege grounds. Accordingly, there was no adverse ruling by the trial court which respondents could present to the court of appeals and it has never been held that respondents are compelled, on pain of an implied waiver, to raise on appeal a defense which was not passed on by the court below. Compare *Moulor* v. *American Life Ins. Co.*, 111 U.S. 335 (1884); *Chase* v. *United States*, 256 U.S. 1 (1921); *Davis* v. *O'Hara*, 266 U.S. 314 (1924).

Indeed, had respondents attempted to raise their privilege objections on the prior appeal, it is likely that in line with settled appellate practice the court of appeals would have refused to consider the issue until it was first passed on by the trial court. See, *e.g.*, *State Wholesale Groc.* v. *Great Atlantic & Pac. Tea Co.*, 258 F.2d 831, 839 (7th Cir. 1958), *cert. den.* 358 U.S. 947 (1959), where the Seventh Circuit concluded in an analogous situation: "It is elementary that this court, in the exercise of its appellate jurisdiction, will not pass upon any question as to which the district court, without objection of counsel for any party, failed to make a decision." See also, *Donovan* v. *City of Dallas*, 377 U.S. 408, 414 (1964); *Western Pac. R. Co.* v. *United States*, 382 U.S. 237, 246 (1965); *Alaska* v. *American Can Co.*, 358 U.S. 224, 227 (1959).

Conclusion

Since the petition raises only a routine procedural question, which the court of appeals properly resolved by allowing the district court to entertain respondents' privilege objections following the prior appeal, it is readily apparent that none of the "special and important reasons" specified in Rule 19 for the exercise of this Court's supervisory jurisdiction are present here, and it is respectfully requested that the petition for certiorari be denied.

Respectfully submitted,

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SUPREME COURT, U. S.

MAY 9 1969

JOHN F. DAVIS, CLERK

IN THE

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OCTOBER TERM, 1968

No. 1346

GIULIO NATTA ET AL, *Petitioners,*

against

ALEX ZLETZ AND
STANDARD OIL COMPANY OF INDIANA,
Respondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

At issue in this case is "the public interest in seeking the truth about who is entitled to this patent", *Natta* v. *Zletz*, 405 F. 2d 99, 101 (7 Cir. 1968). The prospective patent is an important one; "At stake are licensing fees on a plastic [polypropylene] whose U.S. production is valued at about $200 million this year".[1]

In derogation of the paramount public interest, respondent Standard seeks to exploit the patent system by withholding a mass of relevant documents.[2] Standard has suc-

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[1] The quotation is from the article entitled "Round Won in PP Patent Tangle", *Chemical and Engineering News*, May 5, 1969, p. 7, reproduced as Exhibit A, *infra*, p. 1a.

The same article states that "Polypropylene output will pass 1 billion pound level this year". It also shows that respondent Standard's Avisun subsidiary is expanding to a "250 million pound-per-day capacity".

[2] As the petition notes (Pet. 5, n. 2)*, Standard originally filed a list of hundreds or even thousands of pages of withheld documents. That list has now been supplemented by a "category 4", including innumerable additional pages of withheld material.

* In this reply, "Pet." refers to the Petition and "R. Br." to the "Brief for Respondents in Opposition".

ceeded in the courts below by invoking grossly unorthodox procedures, inconsistent with the rulings of this Court. By its opposition to the present petition Standard seeks to foreclose repudiation of these improper procedures and thus to continue exploitation for its private gain not only of the patent system but also the accepted standards of judicial procedure.

THE MANDATE CONFLICT

In derogation of *Briggs* v. *Pennsylvania Railroad Co.*, 334 U.S. 304 (1948), the District Court "deviate[d] from the mandate" of the Seventh Circuit in Appeal No. 16,997. It entered a "Final Order After Remand" (A625) which provides in paragraphs B and D that respondents "shall not be required to produce" a portion of the documents dated subsequent to October 15, 1954 "in the categories already sought by Natta" as the mandate from Appeal 16,997 specifically ordered.[3]

The court below purportedly "affirmed" this prohibited assumption of authority.[4] Respondents seek to camouflage the resulting conflict with *Briggs* by resort to inapposite precedent from this Court.

The apparent success of this same ploy in the Court of Appeals demonstrates the need for review. *If* these inapposite cases *justify* the result below, they are in conflict

[3] The "Final Order After Remand" (A625) included a paragraph *B* providing:

> "B. To the extent it has not already done so, Standard shall produce for inspection by Natta counsel all of the documents with respect to which Standard's objections were sustained by said hereby vacated Final Order, *subject only to the* terms and conditions set forth in the aforementioned *opinion* of the United States Court of Appeals for the Seventh Circuit *and* paragraph *D* hereof;"

Paragraph D defines the purported work product and privileged documents embraced by the mandate which "Standard shall not be required to produce." (A628).

[4] As to the departure from accepted judicial procedures implicit in this purported "affirmance", see *infra*, p. 6, and Pet. 8.

with *Briggs*. If they do *not*, the rule in *Briggs* is controlling and has been violated.

Briggs leaves no discretion in either court below to "interpret" the 16,997 mandate to include an exception contradictory of its plain language, *cf.* R.Br. 5. If the mandate in Appeal 16,997 that Standard shall produce documents "if in the categories already sought" *could* be repudiated in either court by an "interpretation" that Standard "shall *not* produce" a portion of these very same documents, the rule in *Briggs* would be chimerical.

Respondents cannot evade the conflict with *Briggs* by positing their "interpretation" contentions on out-of-context statements of this Court in cases involving appellate review of administrative orders.[5] Each of the cited cases is careful to emphasize that the order in question "was not a mandate from court to court but from a court to an administrative agency" which "involved" a "much deeper issue". *F.C.C.* v. *Pottsville Broadcasting Co.*, 309 U.S. 134, 140-141 (1940). In *this* case a "mandate from court to court" *is* involved.

Nor can respondents rationalize the conflict with *Briggs* by reference to *Sprague* v. *Ticonic National Bank*, 307 U.S. 161 (1939) (R.Br. 6). In *Sprague* this Court said that the "general proposition" that a lower court is "bound to carry the mandate of the upper court into execution . . . is indisputable. . . . But that leaves us still to consider whether the immediate issue now in controversy was disposed of in the main litigation and therefore foreclosed by the mandate. While *a mandate is controlling* as to matters *within its compass*, on the remand a lower court is free as to other issues" (307 U.S. at 168, emphasis added).

The mandate in Appeal No. 16,997 *includes* "within its compass" the post-October 15, 1954 documents for which Standard now asserts work product and privilege claims.

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[5] To wit, *F.C.C.* v. *Pottsville Broadcasting Co.*, 309 U.S. 134 (1940); *N.L.R.B.* v. *Donnelly Garment Co.*, 330 U.S. 219 (1947); and *F.T.C.* v. *Colgate-Palmolive Co.*, 380 U.S. 374 (1965) (R. Br. 5).

If it did *not*, respondents' insistence upon the *inclusion* in the "Final Order" of paragraph D *expressly to exclude* such documents from the mandate's "compass" *would have been quite unnecessary.*[6]

Because the documents are "within" the "compass" of the mandate, the consequence of respondents' conduct was waiver—not preservation—of the privilege and work product claims. See *Sprague, supra,* 307 U.S. at 169, and the cases cited at Pet. 12-13, par. 3.

THE WAIVER CONFLICT

Respondents only answer to the "waiver" conflict is an evasion posited on a misrepresentation of the record. Respondents allege that their privilege and work product contentions—admittedly "emphasized . . . throughout the district court proceedings" (R.Br. 2, n. 2)—were "a defense which was not passed on by the court below" (R.Br. 7) prior to Appeal 16,997.

The district judge's *own* construction of his May 16, 1968 final order made in open court on January 17, 1969 at the first hearing after issuance of the 16,997 mandate is to the contrary. On that occasion the district judge said: "Well, I had sustained their [respondents'] objection. It would have been up to you [petitioners] to have gotten it reversed on that [*i.e.,* privilege and work prod-

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[6] The circumstance that respondents' paragraph D would have been unnecessary if the documents it would now withhold were *not* within the "compass" of the mandate, exposes the fallacy of respondents' attempt to rely upon the cases cited at R. Br. 6, first full paragraph.

Respondents' suggestion that the opinion in Appeal 16,997 by its reference to Rule 34's exclusion of "privileged matter" seems to indicate it believed respondents' claims should be sustained" (R. Br. 6, n. 4), is not consistent with what the court said. The thrust of the court's comment is to emphasize the broad scope of discovery which Rule 34 contemplates and to make it clear that under that rule documents "may not be withheld on the grounds of irrelevancy" (A594).

Because no document is "privileged" until the facts prerequisite to the immunity are proved, Standard, having made no attempt to discharge that burden, *had no* "privileged" documents at the time Appeal 16,997 was argued.

uct], too'' (A607). The record antecedent. Appeal 16,997 fully supports the judge and flatly repudiates respondents' present inconsistent contentions.

The May 16, 1968 ''Final Order'' of the district court (A579-81) is in all material respects verbatim with respondents' ''proposed final order'' (A541-3) filed *appended* to respondents' formal written ''objections'' (A539-40). These formal objections included a generic objection to producing documents dated after October 15, 1954, *inter alia,* because *''many of said documents represent work product and are privileged''* (A539). Respondents' *appended* ''proposed final order'' included a ruling (par. 4) that ''Zletz's . . . objection to producing documents dated subsequent to October 15, 1954 is sustained'' (A543)—which was verbatim adopted by the district court (A581).

Manifestly, the district judge *did* ''pass on'' and ''sustain'' respondents' *whole* objection to producing post-October 15, 1954 documents, including the portion which rested on privilege and work product grounds. There was accordingly no occasion for petitioners to except, as respondents insist they should have, to the judge's ''failure to pass on the privilege issue in its May 16, 1968 order'' (R.Br. 3; *cf.* R. Br. 7).[7]

And it follows that the cases cited by respondents at R.Br. 7, all of which deal with *expressly reserved* or otherwise severed issues, are off-point. Respondents *could* have sought an *express* severance prior to the issuance of the 16,997 mandate.[8] Their failure to do so is significant in

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[7] Respondents' position is, in essence, that they had the right to "preserve" *sub silentio* an argument for withholding a part of the documents covered by the May 16, 1968 final order and to reveal their hand only *after* petitioners had succeeded on Appeal 16,997 in obtaining a ruling that *all* post-October 15, 1954 documents "in the categories already sought" should be produced. If it is endorsed by this Court, litigants will be well-advised to consult soothsayers in preference to counsel for guidance on procedural problems.

[8] Throughout the lengthy district court proceedings prior to the May 16, 1968 final order, respondents made no effort to prove facts to establish their work product and privilege claims. Presumably their failure to press

illustrating the depth of conflict between the court below and the cases cited at Pet. 12-13, par. 3.

THE PURPORTED "AFFIRMANCE" BELOW

Respondents *ignore* the significant departure below from established judicial procedural standards by which the "Final Order After Remand" was "construed" to include an unrecited provision (Pet. 8) rendering it *nonfinal* and hence beyond the lower court's power to "affirm". *Cf.* 28 U.S.C. 1291. As written, the "Final Order After Remand" permits respondents to judge the merit of their own work product and privilege claims. It fails to afford petitioners the right to contest "Standard's work product and privilege claims on the merits before the district court" (Pet. App. 5a) so conveniently imputed to it by the lower court.

Such departure below from procedural regularity has spawned an even more aberrant ruling in the district court by which respondents will collaborate with the district judge in passing on the merits of the privilege and work product claims. On May 1, 1969 the trial judge ordered in open court that the mass of documents for which Standard asserts immunities will be considered *in camera* based on arguments and alleged "testimony" by respondents' counsel to be presented in an unprecedented *ex parte* proceeding from which petitioners and their counsel will be excluded.[9] Petitioners will likewise be foreclosed from access to the transcript, which will be sealed.

This abortion of the lower court's misplaced effort to "save" the "Final Order After Remand" through imputing to it an unrecited due process recognition of petition-

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the merits of these claims affirmatively during Appeal 16,997 was premised on a recognition that the record factual support was lacking.

[9] Respondents are *wrong* in asserting that the "petition elsewhere recognizes (p. 5, n. 2) [that] the district court is presently considering respondents' privilege claims as to individual documents based on an *in camera* review of such documents" (R. Br. 4, n. 3). The petition makes *no* reference to *in camera* review either in the cited portion or elsewhere.

ers' right to be heard but serves to intensify the need for this Court's intervention.

CONCLUSION

Granting of the petition and summary reversal of the decision below are clearly in order.

Respectfully submitted,

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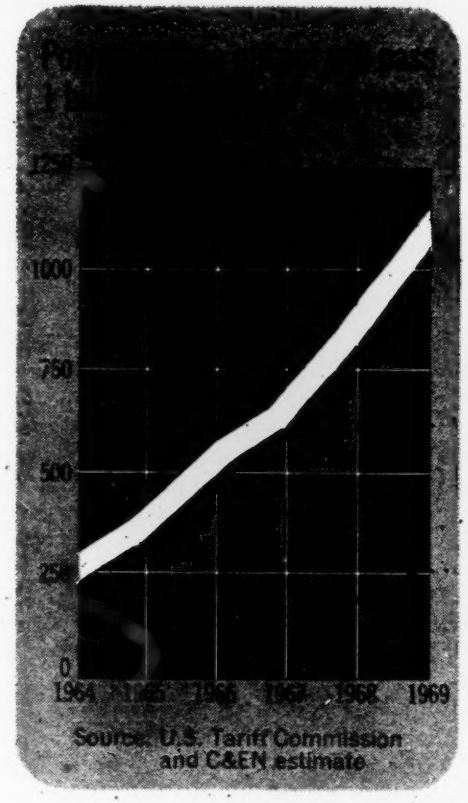
ROUND WON IN PP PATENT TANGLE

The Canadian Patent Office has awarded Dr. Alex Zletz priority of invention for the composition of matter patent on polypropylene. Dr. Zletz is an employee of American Oil Co. and the ruling brings parent Standard Oil (Ind.) a step forward in the contest for ownership of the valuable patent. It is only a first-round victory, however, since other disputants in the case will almost certainly appeal the patent commissioner's ruling in the courts.

Law and chemistry combine to make for confusion where polypropylene patents are concerned. The Canadian Patent Office ruling therefore is the subject of much discussion in the U.S. chemical industry despite the fact that the two patent systems are different and independent.

The question of just who owns the basic patent on polypropylene in the U.S. hasn't been decided either. In fact, infringement proceedings in the U.S. Patent Office have continued for 10 years. As is the case in Canada, any decision can be appealed and lawyers could stay busy for a long time. At stake are licensing fees on a plastic whose U.S. production is valued at about $200 million this year.

Other principals in the Canadian action have six months to appeal the commissioner's finding. Phillips, Du Pont, Montecatini, and Indiana Standard are among the parties in conflict in Canada. Phillips says it doesn't consider the case closed at this point. Du Pont says it is studying whether to appeal or not and a spokesman for Montecatini in the U.S. says he believes appeal is likely. In the event no appeal is lodged, however, a patent would issue to Indiana Standard and the firm would have won royalty rights to crystalline polypropylene produced in Canada.



Dr. Zletz is project manager at American Oil Co.'s Whiting, Ind., lab. His work, which was performed in 1950, covered normally solid crystalline polymers of polypropylene characterized by means of certain infrared absorption bands. Six of nine claims in conflict were awarded to Dr. Zletz in Ottawa.

In the U.S., Du Pont, Phillips, Indiana Standard, and Montecatini are in interference proceedings at the Patent Office over the basic composition of matter patent on polypropylene. Hercules, though not directly involved in the interference proceedings, is in a position to rejuvenate its claim through the courts. Should Indiana Standard emerge as the victor in the legal maze confronting the contesting firms, it has already agreed to license its polypropylene technology.

American Oil and its parent Standard Oil (Ind.) signed a consent order to settle a Federal Trade Commission complaint challenging American Oil's acquisition of Avisun in January 1968. Under terms of the agreement, American Oil agreed to license polypropylene and polypropylene film patent rights and technical information for 10 years (C&EN, June 10, 1968, page 51).

A Montecatini patent for isotactic polypropylene further complicates the overall basic patent issue. The firm was granted U.S. Patent 3,112,300 in 1963 and as a result has filed infringement suits against Chevron Chemical, Avisun, Rexall Drug, and Humble Oil and Refining (C&EN, Feb. 28, 1966, page 26). Du Pont and Montecatini concluded an agreement in 1963 whereby each company obtained a nonexclusive license under U.S. patent rights of the other in the polypropylene field. Hercules is a Montecatini licensee.

Polypropylene production has climbed 35% per year compounded during the 1964–68 period.

A number of firms plan expansions to meet demand in the early 1970's. Enjay Chemical Co. says it will increase capacity to 300 million pounds annually by the second half of 1970. The expansion will be made at Baytown, Tex. The firm's 1967 total capacity was 150 million pounds.

By 1971, Hercules will bring on stream a 180 million pound-per-year polypropylene plant at Lake Charles, La. Lake Charles capacity is presently 370 million pounds per year. Avisun will construct a 150 million pound-per-year polypropylene plant at Chocolate Bayou, Tex., due on stream in 1970. An expansion at New Castle, Del., gives Avisun a 250 million pound-per-day capacity at that site (C&EN, April 14, page 15).